

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Pettitt (TI-28576)

Conf. No. 2019

Serial No. 09/945,295

Group Art Unit: 2625

Filed: August 31, 2001

Examiner: Hung

For: Automated Color Matching for Tiled Projection System

REQUEST FOR RECONSIDERATION

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

This paper is presented in response to the Office Action mailed October 24, 2007. Reconsideration of this application, considering the arguments presented in this paper, is respectfully requested.

Claims 1, 4 through 13, 16 and 18 are in this case. No claim is amended.

Claim 1 was finally rejected under §103 as unpatentable over the Oguchi et al. reference¹ in view of the Mendelson et al. reference². Claims 4, 10, 12, 13, and 16 were finally rejected under §103 as unpatentable over the Oguchi et al. reference in view of the Mendelson et al. reference, and further in view of the Sato reference³. Claim 5 was finally rejected under §103 as

¹ U.S. Patent No. 6,340,976 B1, issued January 22, 2002 to Oguchi et al., from an application filed August 17, 1999 via PCT International Application PCT/JP98/01709 filed April 15, 1998.

² U.S. Patent No. 6,559,826 B1, issued May 6, 2003 to Mendelson et al., from an application filed February 10, 2000, and which is apparently a continuation-in-part of an application No. 09/187,161, filed on November 6, 1998, now abandoned.

³ U.S. Patent No. 6,467,910, issued October 22, 2002 to Sato.

unpatentable over the Oguchi et al. reference in view of the Mendelson et al. reference, and further in view of the Onuma et al. reference⁴. Claim 6 was finally rejected under §103 as unpatentable over the Oguchi et al. reference in view of the Mendelson et al. reference, and further in view of the Noguchi reference⁵. Claim 7 was finally rejected under §103 as unpatentable over the Oguchi et al. reference in view of the Mendelson et al. reference, and further in view of the Yoshikuni reference⁶. Claims 8 and 9 were finally rejected under §103 as unpatentable over the Oguchi et al. reference in view of the Mendelson et al. reference, and further in view of the Appel reference⁷. Claims 11 was finally rejected under §103 as unpatentable over the Oguchi et al. reference in view of the Mendelson et al. reference, and further in view of the Gibson reference⁸. Claim 18 was finally rejected under §103 as unpatentable over the Oguchi et al. reference in view of the Mendelson et al. and Sato et al. references, and further in view of the Gibson reference.

Applicant respectfully maintains that the Mendelson et al. reference is not available as prior art against the claims in this case, for the reasons discussed below.

As previously argued, this application claims priority to provisional application No. 60/229,625, filed August 31, 2000, and is entitled to an effective filing date of August 31, 2000. Accordingly, the Mendelson et al. reference is not available as a reference under §102(b) against the claims in this case, because its issue (and first publication) date is after the effective filing date of this application.

As submitted in the previous Request for Reconsideration on September 10, 2007, Applicant submitted evidence of conception and diligent efforts toward reduction to practice that predate the February 10, 2000 filing date of the Mendelson et al. reference. The Examiner has apparently accepted that evidence, but has now asserted that the effective date of the Mendelson et al. reference is the November 6, 1998 filing date of now-abandoned U.S. application S.N.

⁴ U.S. Patent No. 5,287,173, issued February 15, 1994 to Onuma et al.

⁵ U.S. Patent No. 6,101,272, issued August 8, 2000.

⁶ English language abstract of Japan Patent Publication 02-001351, dated January 5, 1990, based on an application filed by Yoshikuni.

⁷ U.S. Patent No. 5,337,410, issued August 9, 1994 to Appel.

⁸ U.S. Patent No. 5,253,043, issued October 12, 1993 to Gibson.

09/187,161, to which the Mendelson et al. reference claims priority under 35 U.S.C. §120 as a continuation-in-part.

In maintaining this rejection, the Examiner asserts that the now-abandoned U.S. application S.N. 09/187,161 "contains sufficient support, in compliance with 35 U.S.C. §112 ¶1, for the subject matter relied upon to make the rejection."⁹ On this basis, and on this basis alone, the Examiner maintained that the Mendelson et al. reference has an effective date, as a prior art reference, of the filing date of now-abandoned U.S. application S.N. 09/187,161 to which it claimed priority, namely November 6, 1998. Based on this conclusion, the Examiner asserted that Applicant's Declaration was ineffective to antedate the reference, and that the rejection therefore stood.

Applicant first respectfully, yet strenuously, objects to the failure of the Examiner to provide a copy of the now-abandoned U.S. application S.N. 09/187,161 to counsel for Applicant. In the Request for Reconsideration of September 10, the undersigned noted that the contents of the now-abandoned U.S. application S.N. 09/187,161 were not available via Public PAIR (subtly inviting the Examiner to provide a copy).¹⁰ However, the Examiner now states:

[Note: A copy of the abandoned '161 application is not provided since it has never been published.]

The undersigned is incredulous at this statement. Is the Examiner asserting that Applicant is not *entitled* to view a copy of the very document upon which the Examiner is basing the rejection? Apparently so.¹¹ Furthermore, it is clearly evident from the Office Action that the now-abandoned U.S. application is available to the Examiner.¹² Yet despite the application being available to the Examiner, and despite the undersigned expressly indicating that the application is not available to him, the Examiner refuses to provide Applicant with the contents of that now-

⁹ Office Action of October 24, 2007, page 3, *citing* now-abandoned U.S. application S.N. 09/187,161 at its Figures 6, 7, and 9, and its pages 21 through 23.

¹⁰ Request for Reconsideration of September 10, 2007, page 3, *fn.* 11.

¹¹ Of course, Applicant *is* entitled to view the contents of the now-abandoned application. *See* 37 C.F.R. §1.14(a)(1)(iv).

¹² Since the Examiner is citing to it chapter and verse.

abandoned application.¹³ This is hard to believe. The Examiner has left Applicant in the situation of arguing over the contents of an unavailable reference that the Examiner has in his or her possession, but does not provide to Applicant. In effect, Applicant has had his claims rejected in view of *secret prior art*.

Applicant therefore submits that, in the interests of justice, the Examiner provide him with a copy of the now-abandoned U.S. application S.N. 09/187,161 upon which the rejection is based. Applicant also submits that the interests of justice require that prosecution be reopened so that Applicant has a fair opportunity to respond to the rejection, once that copy is provided.

Secondly, Applicant submits that the final rejection of the claims in this case, as unpatentable over combinations of prior art that each include the Mendelson et al. reference, is in error on its face, because it fails to establish that the Mendelson et al. reference is entitled to the benefit of priority to the now-abandoned U.S. application S.N. 09/187,161. The domestic priority statute, 35 U.S.C. §120, reads:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application . . .¹⁴

It is axiomatic, given this statute, that for a patent to be entitled to the priority of a previously-filed application, the “invention” *of that patent* must be disclosed in the previously-filed application. In other words, at least one claim of that patent must be fully supported by the previously-filed application, in order for the patent to be afforded the priority of the previously-filed application.

Applicant raised this very point in the Request for Reconsideration of September 10, 2000, because the Examiner had not alleged that any claim of the Mendelson et al. reference is supported by the now-abandoned U.S. application S.N. 09/187,161. Nor does the Examiner so allege even in response to Applicant’s point.

¹³ While having the nerve to state “*see* Figs. 6, 7, and 9 and pp. 21 – 23 of the ‘161 application”. Office Action, *supra*, page 3 (emphasis added).

¹⁴ 35 U.S.C. §120.

Rather, the Examiner merely asserts that the subject matter relied upon to make the rejection is contained within the contents of the now-abandoned U.S. application. This, however, puts the cart before the horse. The now-abandoned U.S. application S.N. 09/187,161 is itself not prior art, because it neither issued nor was published. Its contents are relevant only if the Mendelson et al. reference actually has priority to its filing date, and that priority is established only if the invention *claimed in the Mendelson et al. reference* is disclosed in the now-abandoned application. Because the Mendelson et al. reference is on its face a continuation-in-part, it necessarily involves new matter relative to the now-abandoned U.S. application S.N. 09/187,161, making it far from a foregone conclusion that the now-abandoned application supports any claim in the reference. And if no claim in the Mendelson et al. reference is supported, and if therefore the reference cannot in fact claim priority to the now-abandoned application under §120, the contents of that now-abandoned application are not relevant to the claims in this case. The Examiner has not even asserted that any such claim is so supported, much less proven that such is the case.¹⁵

Applicant therefore submits that, based on the facts of record in this case, the Mendelson et al. reference is not entitled to the filing date of the now-abandoned U.S. application S.N. 09/187,161 to which it claims priority as a continuation-in-part. Because each basis of the final rejection in this case is based on a determination that the Mendelson et al. reference is entitled to that filing date of November 6, 1998, the final rejection is in error and should be withdrawn.

Each basis of rejection against the claims in this case is a §103 patentability rejection, and is based on the combination of the Mendelson et al. reference with other prior art. Because the Mendelson et al. reference has not been established to be available as prior art against the claims in this application, each basis of rejection in this case is in error. Applicant therefore submits that all claims are in condition for allowance.

Alternatively, should the Examiner present a copy of the now-abandoned application on which the final rejection is based, and assert that a claim in the Mendelson et al. reference is

¹⁵ Nor can Applicant review the contents of the now-abandoned application to make his own determination of this question, as discussed above.

supported by that now-abandoned application, Applicant requests that prosecution be reopened to provide Applicant with an opportunity to respond to the basis of the rejection.

Favorable reconsideration of this application is requested.

Respectfully submitted,
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